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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/440,137 11/15/99 TAKEUCHI

H 1232-19

EXAMINER

IM22/0726

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PADEN, C

ART UNIT

PAPER NUMBER

1761

DATE MAILED:

07/26/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/440,137

Applicant(s)

TAKEUCHI ET AL.

Examiner

Carolyn Paden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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The request filed on June 12, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/440,137 is acceptable and a CPA has been established. An action on the CPA follows.

Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant filed a ~~substitute specification that contains new matter.~~ The specification has been amended to change "middle" to medium and "rate" to "ratio" to amount. Applicant has not provided any particular objective evidence by way of a discussion of the problems relating to translating Japanese into English. Further a CPA may not introduce new matter into the specification under 37 CFR 1.53d. Examiner does not agree that the amended specification does not contain new matter.

The rejection over Kashiwabara has been dropped because it is not directed to a fat or oil composition. The rejection over Hunger, Senda, Benita and Menz has been dropped because it is not directed to a triglyceride having two MCT fatty acids.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 9, 10, 11 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by El-Nokaly (5,192,572) and see column 4, lines 23-40.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, 11 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, <sup>(b) (1)</sup> in the alternative, under 35 U.S.C. 103(a) as obvious over Babayan in light of Gunstone.

Babayan discloses a structured lipid containing dairy fat. The fat is made by the random interesterification of 35-40% medium chain triglycerides and 50-60% dairy fat. There is no specific suggestion that the composition contains the triglyceride with two MCT but this feature would be expected to result from the random interesterification of the oils (note Gunstone at page 145 for support of this assertion). Also butterfat and dairy fat are known to contain a substantial amount of long chain fatty acids (note Gunstone at page 24).

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babayan in light of Gunstone as applied to claims 9, 10, 11 and 14 above, and further in view of 21 CFR 166.4, page 408 and Gunstone taken together.

Babayan discloses a structured lipid containing dairy fat. The fat is made by the random interesterification of 35-40% medium chain triglycerides and 50-60% dairy fat. There is no specific suggestion that the composition contains the triglyceride with two MCT but this feature would be expected to result from the random interesterification of

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the oils (note Gunstone at page 145 for support of this assertion). Also butterfat and dairy fat are known to contain a substantial amount of long chain fatty acids (note Gunstone at page 24). The fat is described for use in margarines in example 4. The claims appear to differ from Babayan in the suggestion of the inclusion of an emulsifier. Gunstone teaches that margarines are well known to contain 80% fat. 21 CFR teaches that margarines are well known to prepare margarine with the amount and kind of emulsifiers that are set forth in the claims. It would have been obvious to use the formulation of Gunstone and 21 CFR to utilize the fat of Babayan to make a margarine product.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Paden whose telephone number is 703-308-3294. The examiner can normally be reached on Monday to Friday from 7am to 3:30pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*Carolyn Paden*  
CAROLYN PADEN 7-25-01  
PRIMARY EXAMINER